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Filed : July 28, 2003

## REMARKS

Claims 1-3, 7-10, 15-17, 21-25, and 29-30 stand rejected under 35 U.S.C. § 102, while claims 4-6, 11-14, 18-20, and 26-28 stand rejected under 35 U.S.C. § 103. Applicant traverses all the rejections; however, in order to advance the case in an expeditious manner, Applicant has canceled claims 15-30 without prejudice while reserving the right to continue prosecution of these claims at a later time. Applicant has added new claims 31-39, which more particularly point out and distinctly claim particular embodiments of Applicant's invention that further distinguish over the prior art of record.

The Examiner has also objected to certain informalities in the disclosure. Accordingly, Applicant has amended the specification to correct these and other informalities found in the specification.

### Claims 1-3 and 7-10 Are Not Anticipated by U.S. Patent No. 6,197,057 ("Peyman et al.").

Claims 1-3 and 7-10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. ("Peyman et al."). Applicant traverses the rejection for the following reasons.

Peyman et al. teaches a supplemental intraocular lens to modify the lens system of an eye comprising the cornea and the natural lens or an intraocular lens already implanted in the eye. In one embodiment, the supplemental intraocular lens has substantially no refractive power except for a high minus lens portion at its center. When a spectacle lens is placed in front of the cornea, the spectacle lens, cornea, natural or intraocular lens and supplemental intraocular lens provide the eye with magnified and restricted peripheral vision. Peyman et al., Abstract. In another embodiment, Peyman teaches a supplemental intraocular lens 166 that has no or substantially no refractive power. Peyman et al., column 8, line 67 – column 9, line 1. As shown in Figure 25 of Peyman et al., the supplemental intraocular lens 166 acts in conjunction with the cornea 102 and natural lens 106 to create a prismatic lens system which focuses light rays 114 onto a portion of the retina 110 away from the macula 112. Peyman et al., column 9, lines 21-25. In such embodiments, the supplemental intraocular lens 166 may have a prism-shaped cross section or any suitable shape which does not provide any refractive power but diffracts light rays. Peyman et al., column 9, lines 8-12. While Peyman et al. mentions shapes that "diffract" light rays, no enabling

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disclosure nor even any specific examples of a diffractive element is provided. Peyman, column 9, lines 12-14.

By contrast, claim 1 is directed to an intraocular lens comprising, among other things, a supplemental intraocular lens...to modify vision correction provided by the primary intraocular lens...comprising a substantially completely diffractive optic. Peyman et al. does not teach or suggest a diffractive optic to modify vision correction provided by a primary intraocular lens. To the contrary, Peyman et al. teaches a prism or other shape which does not provide any refractive power (or diffractive power). Peyman et al., column 8, line 67 to column 9, line 1, and column 9, lines 10-11. Thus, the prisms or other shapes taught by Peyman et al., fail to provide either a refractive or diffractive power required to modify vision correction provided by a primary intraocular lens. Rather, these prisms or shapes act in conjunction with the cornea 102 and natural lens 106 to create a prismatic lens system which focuses light rays 114 onto a portion of the retina 110 away from the macula 112. Peyman et al., Figure 25 and column 9, lines 21-25. Therefore, Peyman et al. does not teach a diffractive optic to modify vision correction provided by a primary intraocular lens, but instead teaches a prism or other shape to translate the focus away from the macula by acting in conjunction with cornea and natural lens to create a prismatic lens system. See Peyman et al., column 9, lines 21-25.

Applicant further asserts that Peyman et al. does not even provide an enabling teaching of a diffractive optic, much less a diffractive optic to modify vision correction provided by a primary intraocular lens. Rather, Peyman et al. teaches a supplemental intraocular lens that can be shaped as a prism or a suitable shape which does not provide any refractive power. See Peyman et al., column 8, line 67 to column 9, line 1, and column 9, lines 8-11. Peyman et al. mentions that the suitable shape “diffracts the light rays in the manner described below” (Peyman et al., column 9, line 11-12), but fails to provide any enabling disclosure or even an example of a diffractive optic that “diffracts light rays”. Rather, Peyman et al. teaches that the suitable shape can have “multiple grooves similar to a fresnel lens, or have steps or lines across its surface which diffract the light rays.” Peyman et al., column 9, lines 12-14. One of ordinary skill in the art understands that a Fresnel lens is not a diffractive optic, because the phase difference between the faceted zones of a Fresnel lens are random. See, for example, U.S. Patent Application Number 2005/0027354 (Applicant’s published application) in paragraph [0030]. Thus, while Peyman et al. mentions a

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suitable shape that he asserts diffracts light, Peyman et al. never teaches or even provides an example of a diffractive optic that diffracts light, as recited in Applicant's claim 1.

At least because Peyman et al. does not teach or suggest all of the limitations of claim 1, Applicant requests the Examiner to indicate that claim 1 is allowable. Claims 2, 3 and 7-10 depend from claim 1 and further define the invention of claim 1. Thus, claims 2, 3 and 7-10 are patentable over Peyman et al. at least for the same reasons that claim 1 is patentable thereover, and are patentable in their own right as well.

Claims 4-6 and 11-14 Are Patentable Over Peyman et al. and U.S. Patent Nos. 5,366,502 ("Patel") and 6,197,058 ("Portney") and U.S. Patent Application Publication Nos. 2003/0097176 ("Nordan et al.") and 2002/0042653 ("Copeland et al.").

Claims 4-6 and 11-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Peyman et al. in view of U.S. Patent Nos. 5,366,502 ("Patel") and 6,197,058 ("Portney") and U.S. Patent Application Publication Nos. 2003/0097176 ("Nordan et al.") and 2002/0042653 ("Copeland et al."). Applicant respectfully asserts that a prima facie case of obviousness has not been made, since none of these references teach all the limitations of Applicant's claim 1, from which claims 4-6 and 11-14 depend. Specifically, none of references teach, either alone or in combination, a supplemental intraocular lens...to modify vision correction provided by the primary intraocular lens...comprising a substantially completely diffractive optic.

At least because Peyman et al. and Patel, Portney, Nordan et al., or Copeland et al. do not teach or suggest all of the limitations of claim 1, Applicant requests the Examiner to indicate that claims 4-6 and 11-14, which depend on claim 1, are allowable at least for the same reasons that claim 1 is patentable thereover, and are patentable in their own right as well.

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### **CONCLUSION**

For the foregoing reasons, Applicant respectfully asserts that the claims now pending are allowable over the prior art of record. Therefore, Applicant earnestly seeks a notice of allowance and prompt issuance of this application.

The Commissioner is hereby authorized to charge payment of any fees associated with this communication to Deposit Account No. 502317.

Respectfully submitted,  
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